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10/774,264	02/05/2004	George Bayer	2350.422	8672

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ALBANY, NY 12203

EXAMINER

REESE, DAVID C

ART UNIT PAPER NUMBER

3677

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Mc*

**Office Action Summary**

Application No.

10/774,264

Applicant(s)

BAYER ET AL.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,7,9,10,12-14,23-25,29-39,44,46,50,51 and 54-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3,4,7,9,10,12-14,23-25,29-38,44,46,50,51, and 54-64 is/are rejected.
- 7) ☒ Claim(s) 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to Applicant's amendment filed 8/1/2005.

#### ***Status of Claims***

- [1] Claims 1, 3-4, 7, 9-10, 12-14, 23-25, 29-39, 44, 46, 50-51, and 54-64 are pending.

#### ***Claim Objections***

- [2] Claim(s) 6 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 8/1/2005. Accordingly, the objection(s) to the claim(s) 6 have been withdrawn.

#### ***Claim Rejections - 35 USC § 112***

- [3] Applicant has addressed all rejections under 35 USC § 112 to the Claims in the amendment filed 8/1/2005. Accordingly, the Examiner has withdrawn the 35 USC § 112 rejections.

#### ***Claim Rejections - 35 USC § 102***

- [4] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international

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application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[5] Claims 1, 3-4, 7, 9-10, 12-14, 44, 46, 50-51, 63-64 are rejected under 35 U.S.C. 102(b) as clearly anticipated by DE 2127913 because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

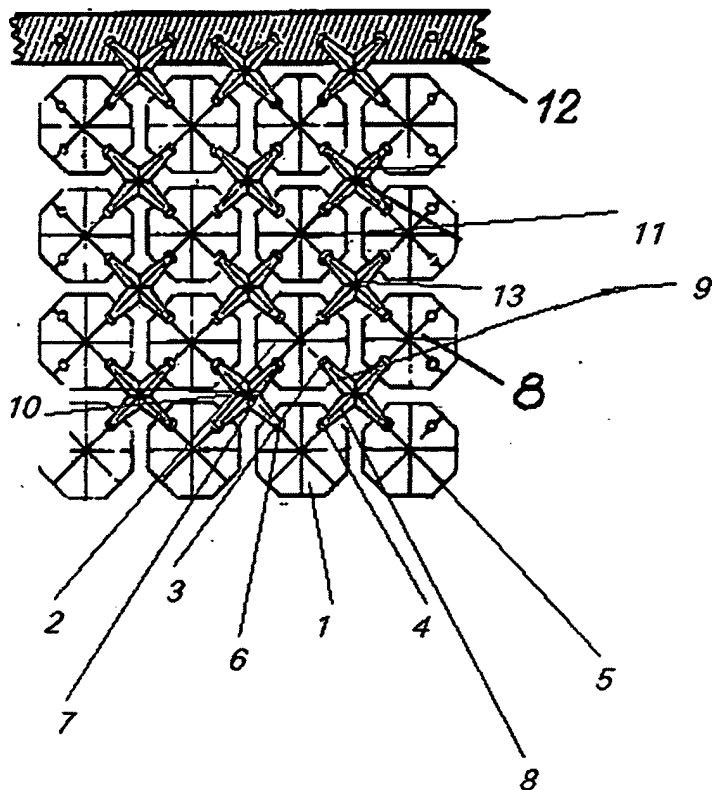
The shape and appearance of DE 2127913 is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, DE 2127913 teaches of a arrangement/link construction for a crystal pendant, the arrangement (Fig. 10) comprising:

- a first ornament (1) having at most a first aperture (4) and a second aperture (6);
- a second ornament (2) having at least a first aperture (3) and a second aperture (7); and
- a first connector (9) having a first end (8) adapted to be mounted to the first aperture (4) of the first ornament (1) and a second end (9) adapted to be mounted to the first aperture (3) of the second ornament (2), and a second connector (10) having a first end adapted to be mounted to the second aperture (6) of the first ornament (1) and a second end adapted to be mounted to

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the second aperture (7) of the second ornament (2).



whereby the second aperture (6) of the first ornament (1) is laterally disposed from the first aperture (4) of the first ornament (1).

Re: Claim 3, wherein the second aperture (7) of the second ornament (2) is laterally disposed from the first aperture (3) of the second ornament (2).

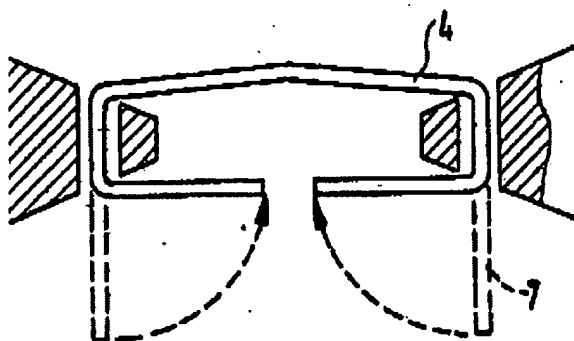
Re: Claim 4, wherein the second aperture (6) of the first ornament (1) is opposite the first aperture (4) of the first ornament (1).

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Re: Claim 7, wherein the second end of the first connector (9) is inserted into the first aperture (3) of the second ornament (2) and the second end of the second connector (10) is inserted into the first aperture (3) of the second ornament (2).

Re: Claim 9, further comprising at least a third ornament (11) having at least one aperture and at least one third connector (13) connecting the second ornament (2) and the third ornament (11).

Re: Claim 10, wherein at least the first connector (9) comprises at least one-pre-formed U-shaped connector having ends adapted to be inserted into and secured to an aperture of an ornament (see below).



Re: Claim 12, wherein the decorative ornaments comprises one or more of beads, crystals, stones, and gems.

Re: Claim 13, wherein at least the first connector (9) comprises a metallic wire having a diameter between about .0625 inches and about .125 inches.

Re: Claim 14, wherein the first ornament (1) and the second ornament (2) comprise octagonal ornaments having two through holes (6,4,3,7).

Re: Claim 44, wherein at least the first connector (9) comprises a connector fabricated from one of sheet and plate.

Re: Claim 46, wherein at least the first connector (9) is fabricated from one of sheet and plate and is fabricated by one or more of the following processes: laser cutting, water-jet cutting, and electro-discharge machining.

The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

Re: Claim 50, wherein the first ornament (1) and the second ornament (2) comprise two of a plurality of ornaments providing an ornament chain (see figure above).

Re: Claim 51, wherein the ornament chain is at least 5 feet in length (see figure above).

Re: Claim 63, wherein the first connector (9) and the second connector (10) comprise at least one pre-formed U-shaped connector having ends adapted to be inserted into and secured to an aperture of an ornament (see above diagram).

Re: Claim 64, wherein the first connector (9) and the second connector (10) comprise metallic wire having a diameter between about .0625 inches and about .125 inches (see diagram above).

[6] Claims 23-25, 54-59 are rejected under 35 U.S.C. 102(b) as clearly anticipated by EP 0200924 because the invention was patented or described in a printed publication in this or a

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foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of EP 0200924 is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 23, EP 0200924 teaches of a arrangement/link construction for a crystal pendant, the arrangement (Fig. 10) comprising:

- at least one ornament (6) having a first aperture and a second aperture; and

- at least one hook (8) having a first end (105) adapted to be inserted and secured to the first aperture of the ornament (6), a second end (105) adapted to be inserted and secured to the second aperture of the ornament (6), and a loop (below 8) positioned between the first end and the second end, the loop (below 8) adapted to be hung from a support;

- wherein, when hung by the loop (below 8), the second aperture of the ornament is laterally disposed from the first aperture of the ornament.

Re: Claim 24, wherein the one or more decorative ornaments (6) comprise one or more of beads, crystals, stones, and gems.

Re: Claim 25, wherein the at least one hook comprises a wire (105) having a diameter between about .0625 inches and about .125 inches.

As for Claim 54, EP 0200924 teaches of an arrangement for connecting decorative ornaments the arrangement (Fig. 10) comprising:

- a first ornament (top 6) having at most a first aperture and a second aperture;

- a second ornament (second 6) having at least a first aperture;



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at least a third ornament (third 6) having at least one aperture; and

at least one continuous connector (5) passing through an aperture of at least the first ornament (top 6), the second ornament (second 6), and the third ornament (third 6);

whereby the second aperture of the first ornament (second 6) is laterally disposed from the first aperture of the first ornament (top 6).

Re: Claim 55, wherein the at least one continuous connector (5) comprises a connector fabricate from one of sheet and plate.

Re: Claim 56, wherein the at least one connector (5) comprises at least two connectors (5,5).

Re: Claim 57, wherein the at least one continuous connector (5) fabricated from one of sheet and plate is fabricated by one or more of the following processes: laser cutting, water-jet cutting, and electro-discharge machining.

The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F2d 742, 180 USPQ 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

Re: Claim 58, wherein the first ornament (top 6), second ornament (second 6), and third ornament (third 6) comprise a plurality of ornaments providing an ornament chain (Fig. 10).

Re: Claim 59, wherein the ornament chain is at least 5 feet in length (Fig. 10).

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[6] Claims 29-38, 60-62 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Schonbek, US- 5,144,541, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 29, Schonbek teaches of a gallery assembly for chandeliers, the device comprising:

a plate having an edge (outside edge of 112 in Fig. 5); and

a channel in the plate (88) having an open first end (112) located at the edge of the plate, a closed second end (70), the channel comprising a horizontal passage (110) and at least one vertical passage (between 110 and 88) located between the open first end (112) and the closed second end (70);

wherein the channel (88) is adapted to receive the hook of the ornament and support the hook in the closed second end of the channel (Fig. 8).

Re: Claim 30, wherein the channel (88) further comprises an expansion in the vertical passage (between 110 and 88).

Re: Claim 31, wherein the closed second end (70) comprises a convergent closed second end (top of that between 110 and 88).

Re: Claim 32, wherein the convergent closed end converges to a point (the point between the top of that between 110 and 88).

Re: Claim 33, wherein the channel comprises a channel (112) that passes through the thickness of the plate.

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Re: Claim 34, wherein the at least one vertical passage (between 110 and 88) of the channel (88) comprises at least two vertical passages.

Re: Claim 35, wherein the mounting hook of the ornament comprises a mounting loop (82 in Fig. 8).

Re: Claim 36, wherein the mounting loop comprises a wire mounting loop (82 in Fig. 8).

As for Claim 37, Schonbek teaches of an arrangement for mounting a decorative ornament on a fixture, the decorative ornament having a preferred direction of orientation; the arrangement comprising:

a mounting hook (82 in Fig. 8) adapted to be attached to the decorative ornament (76);

a plate having a planar surface and an edge (outside edge of 112 in Fig. 5); and

a channel (88) in the plate having an open first end (112) located at the edge of the plate, a closed second end (70), comprising a horizontal passage (110) and at least one vertical passage (between 110 and 88) located between the open first end (112) and the closed second end (70);

wherein the channel (88) is adapted to receive the hook (82) of the ornament and support the ornament whereby the preferred direction of orientation of the ornament is directed substantially parallel to the planar surface of the plate (Fig. 8).

Re: Claim 38, wherein the fixture comprises a circular fixture (Fig. 5) having a radial direction (70 to the edge of 112), wherein the planar surface of the plate and the preferred direction of orientation of the ornament are directed in the radial direction of the fixture.

Re: Claim 60, wherein the plate comprises a vertically oriented plate (70 in Fig. 6).

Re: Claim 61, wherein the edge comprises a bottom edge of the vertically oriented plate (bottom of 112).

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Re: Claim 62, wherein the channel (88) further comprises an abrupt enlargement in width (112-88) adapted to obstruct disengagement of the mounting hook from the channel.

***Response to Arguments***

[7] All arguments are considered moot in view of new grounds of rejection. Also, as a result of newly found art, some of the previously allowed claims and allowable subject matter have been rescinded and are now rejected in view of that above. Due to such, this office action is therefore a non-final rejection.

***Allowable Subject Matter***

[8] Claim 39 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: the prior art, either alone or in combination with corresponding limitations as stated above, fails to teach or disclose of a hook as stated from Claim 37 comprising a connector having a first end inserted into a first aperture of a ornament and a second end of the said connector inserted in the a second aperture of said ornament (from Claim 39); with said hook being attaching to the channel in the plate with specifications as claimed in Claim 37.

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*Conclusion*

[9] **THIS ACTION IS NON-FINAL**

[10] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. **Please also note the change in the fax phone number to (571) 273-8300 for the organization where this application or proceeding is assigned.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,  
David Reese  
Assistant Examiner  
Art Unit 3677

DCR

  
ROBERT J. SANDY  
PRIMARY EXAMINER